

REMARKS

Upon entry of this Amendment, claims 1-5, 7, 8, 24-41, 44 and 45 are all the claims pending in the application. Claims 6, 9-23, 42 and 43 are hereby canceled and claims 1, 4 and 36 are amended. Claims 1-45 presently stand rejected.

The Examiner has not returned the initialed PTO/SB/08 for the Information Disclosure Statement filed on March 9, 2004.

The Examiner has removed the previous indication of allowability of claims 14 and 24-35 in view of a newly discovered Ishitobi (JP 09148810) and the copending application 09/987,376.

Claims 1, 2, 4-7, 9, 11, 15, 16, 18-22, 36-40 and 42 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ishitobi (JP 09148810).

Claims 3, 10, 13, 43 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishitobi (JP 09148810).

Claims 8, 12, 14, 17, 23, 41 and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishitobi (JP 09148810) in view of Arakawa et al. (USP 6,020,800).

Claims 1-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-62 of copending Application no. 09/987,376. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not been patented.

For the reasons that follow, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

Argument

§102 and §103 Rejections over Ishitobi

In regard to the rejections of claims 1-7, 9-11, 13, 15, 16, 18-22, 36-40, 43 and 44 as being rejected over Ishitobi under either §102 or §103, Applicant submits that the claims have been amended to more clearly distinguish over the cited prior art. In particular, claim 1 has been amended to recite increasing the number of poles per block by providing respective discontinuities on corners of the block resonator along a Y axis, a Z axis and a X axis thereof. None of the prior art references cited teach or suggest this feature. The Examiner asserts, in regard to the rejection of other claims, that it would have been obvious for a skilled artisan to cut an additional corner, i.e., since the prior art references to Arakawa et al. and Ishitobi disclose cutting two corners. The asserted motivation for cutting an extra, third, corner is “because such a routine modification would have provided the obvious advantageous benefit of additional pre-selected modes and orientations of coupling.”

This assertion, however, is entirely unsupportable by the independent disclosures of Ishitobi and Arakawa et al. Nowhere in either of the two cited references is an “obvious advantageous benefit of additional pre-selected modes and orientations of coupling” discussed. The first time such a benefit is discussed is in the current application and, thus, the Examiner’s assertion that the modification proposed is “obvious” is inappropriate since, as espoused by the

Federal Circuit Court of Appeals in *In re Fritch*, “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. For at least this reason, in view of the present claim amendments, the claimed invention is patentable over the cited prior art references, either taken alone or in combination.

§103 Rejection over Ishitobi and Arakawa

In regard to the rejections of claims 8, 12, 14, 17, 23, 41 and 45, in addition to the reason set forth above, Applicant submits that the rejection of claims 8, 12, 14, 17, 23, 41 and 45 should be withdrawn for the following reason as well.

Ishitobi discloses a band pass filter device with three resonance modes where the first and third resonance modes are connected to an external circuit using two respective conductors 41 and 42. (abstract). Contrary to the assertion of the Examiner, however, it would not have been obvious to combine structure of the device of Arakawa et al. with two respective triple mode monoblock structures as disclosed in Ishitobi. For example, there is no disclosure in the prior art, and the Examiner points to none, to support the Examiner’s conclusory finding that it would have been obvious to modify the Ishitobi dielectric block “to have included two blocks joined together such as taught by Arakawa, because it would have provided the well known advantageous benefit of a sharper cutoff of the frequency characteristics.”

Additionally, Applicant submits that the proposed combination would render the Arakawa et al. structure unsatisfactory for its intended purpose. If a proposed modification

would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Specifically, the function of the Arakawa et al. device is that of a two stage band-pass dielectric waveguide filter “wherein the resonance frequencies of the two stages of resonators are determined by the inner diameters of the through-holes 12a and 12b.” (Col. 15, lines 22-29). If the two sections of the waveguide filter of Arakawa et al. were simply replaced with the triple-mode monoblock structures of Ishitobi, as proposed by the Examiner, the resulting structure would not function as a controllable two stage band-pass dielectric waveguide filter, as intended. For this additional reason, the proposed combination of Arakawa et al. and Ishitobi is improper and any rejection based on this combination should be withdrawn.

Double Patenting Rejection

The Examiner is respectfully requested to hold the provisional double patenting rejection in abeyance until such time as when either the present application or the asserted co-pending application, 09/987,376, have been allowed.

Further, it is respectfully noted that since the only current rejection against claims 24-35 is the provisional double patenting rejection, these claims should be found allowable.¹

¹ According to MPEP 804(I)(B), if a provisional double patenting rejection in one application is the only rejection remaining, then the Examiner should withdraw the provisional rejection and permit that application to issue as a patent, thereby converting the *provisional* double patenting rejection in the other application into a *bona fide* double patenting rejection at the time the one application issues as a patent.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/987,353

Conclusion

In view of the foregoing remarks, the application is believed to be in form for immediate allowance with claims 1-5, 7, 8, 24-41, 44 and 45, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to **contact the undersigned** at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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